

REMARKS

Claims 1-49 and 53-55 are currently pending, of which, claims 1, 10, 17, 29, 34, 44 and 49 are in independent form. Independent claims 1, 10, 17 and 29 are apparatus claims, independent claim 34 is a system claim, and independent claims 44 and 49 are method claims. In the outstanding Office Action, the Examiner rejected claims 1-3, 7, 10, 15-23, 25,26, 29-31, 34-40 and 44-48 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3,085,628 to Malone (hereinafter "Malone"). The Examiner rejected claims 4-6, 8, 9, 11-14, 24, 27, 28, 32, 33, 41 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Malone in view of United States Patent No. 6,575,251 to Watson et al. (hereinafter "Watson"). The Examiner rejected claim 43 under 35 U.S.C. §103(a) as being unpatentable over Malone in view of United States Patent No. 4,627,488 to Szarka (hereinafter "Szarka"). The Examiner rejected claims 1-42 and 44-52 under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Malone or United States Publication No. 2004/0020644 in the name of Wilson et al. (hereinafter "Wilson"). The Examiner rejected claim 43 under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Szarka and further in view of Malone or Wilson.

Objections to the Drawings:

The Examiner objected to the drawings on the grounds that the drawings failed to depict a check valve as recited in claims 7, 15,

18, 30, 37, 38, 46 and 50, or a packer 150 as recited in the written description. The Examiner further objected to the drawings on the grounds that they depicted reference numerals 32 and 59 not mentioned in the written description.

With respect to element 59, Applicant respectfully submits that element 59 is described in the written description as a "particulate filter" in, for example, paragraph [0031] of the description. Accordingly, Applicant respectfully submits that no amendment is necessary as to that point. With respect to element 32, Applicant has submitted herewith an amended Figure 1 deleting reference numeral 32 therefrom.

With respect to the "check valve", Applicant has submitted herewith a revised Figure 2 showing "check valve 61". Applicant has amended the written description of Figure 2 to describe "check valve 61." Further, Applicant has omitted the reference in the written description to "packer 150". Applicant respectfully submits that these amendments do not add new matter and their entry is respectfully requested.

Rejections under 35 U.S.C. § 102:

As noted above, the Examiner has rejected claims 1-3, 7, 10, 15-23, 25, 26, 29-31, 34-40 and 44-48 as being anticipated by Malone. In support of the rejection of claim 1, the Examiner asserted the following:

Regarding claim 1.. Malone discloses an inflatable well completion tool that includes an inflatable element 13 and a particulate filter 30' coupled to the element. The element is inflated by fluid filter by the filter. The examiner notes that Malone does not specifically disclose using the tool with gravel slurry, however, the tool would be capable of filtering fluid from gravel slurry if this was the fluid used to inflate the element.

Pending apparatus claim 1 reads as follows:

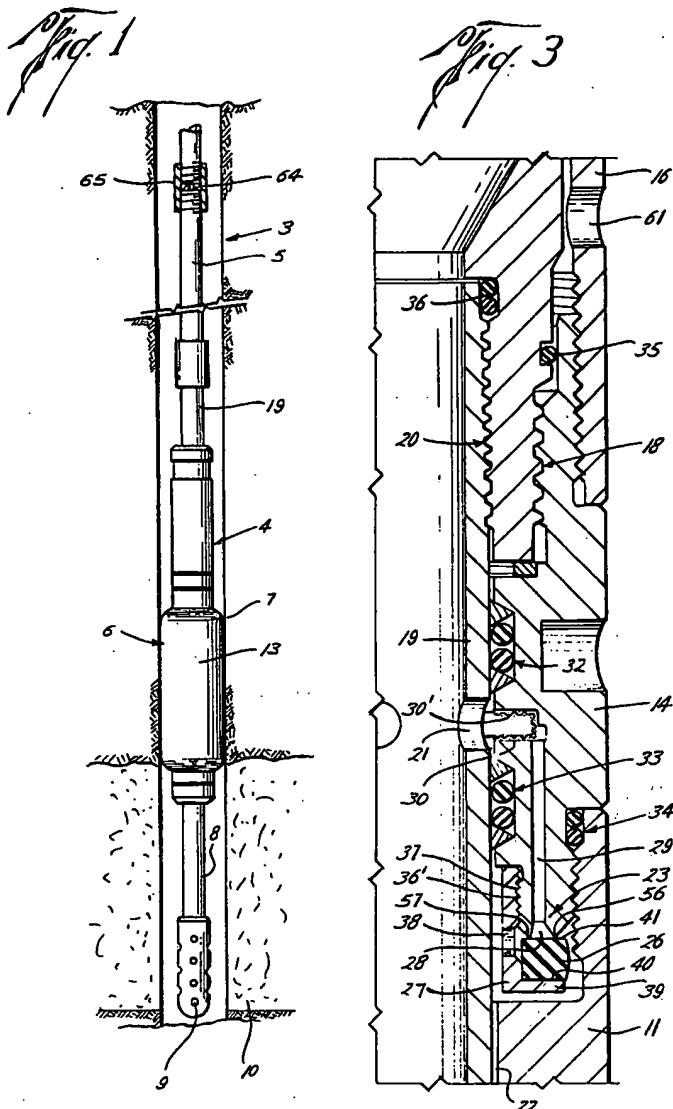
1. (Rejected) An inflatable well completion tool comprising:
 - an inflatable element;
 - a particulate filter operatively coupled to the inflatable element; and
 - wherein the inflatable element is adapted for inflation by an inflating fluid obtained from filtering a gravel laden slurry using the particulate filter.

As apparent upon a review of the above claim, the pending independent claims of the present application are characterized by an inflatable element that is inflated, or adapted to be inflated, by an inflating fluid obtained by ***filtering a gravel laden slurry***.

Each of the remaining independent claims recites a similar limitation. Applicant agrees with the Examiner that Malone does not disclose using the tool with filtered slurry. Applicant respectfully submits that the Examiner's argument that the tool of Malone "would be capable of filtering fluid from gravel slurry if this was the fluid used to inflate the element" is a circular argument. If Applicant understands the Examiner's position correctly, the Examiner argues that Malone would teach inflating the packer with filtered fluid if it taught that filtered fluid were the fluid used to inflate the packer. Applicant respectfully submits that a rejection based on this assertion is not proper.

The Malone Reference

Figure 1 of Malone depicts a well bore 3, which may be open or cased. The inflatable tool 4 is supported on tubing 5. A packer element 6 having an inflatable element 13 is shown in its expanded configuration and in contact with the sides 7 of the well bore 3. Tubing 5 is connected to a pipe 19, which extends through the packer element 6. Pipe 9 is terminated with a bull plug 9 in order to receive flow from the formation 10.



inhibit the settling of foreign matter on the surface 41 of the resilient member 26, which would tend to inhibit sealing.

As noted, Malone does not discuss the use of filter 30' to separate gravel from a slurry, or the use of filtered slurry to fill the inflatable member 13. Accordingly, Applicant respectfully submits that Malone does not teach an inflatable element "adapted for inflation by an inflating fluid obtained from filtering a gravel laden slurry using the particulate filter" as recited in claim 1. For the same reasons, Malone does not teach the similar limitations of claims 2-3, 7, 10, 15-23, 25, 26, 29-31, 34-40 or 44-48 and these claims are therefore not anticipated by Malone.

Rejections under 35 U.S.C. § 103:

The Examiner has rejected claims 4-6, 8, 9, 11-14, 24, 27, 28, 32, 33, 41 and 42 as obvious over Malone in combination with Watson. The Examiner has rejected claims 1-42 and 44-52 as obvious over Watson in view of Malone or Wilson. The Examiner rejected claim 43 under 35 U.S.C. §103(a) as being unpatentable over combinations of Malone, Watson, Wilson and Szarka. The teachings of Malone, and its limitations, have been discussed above. As discussed below, Watson, Wilson and Szarka each fail to correct the deficiencies of Malone.

The Watson Reference

Watson is directed to an inflatable element that is adapted for inflation by gravel laden slurry. Specifically, Watson discloses a method of sealing an annulus in a well comprising expansion of the inflatable element with a gravel laden slurry. The inflatable element comprises a passageway communicating between an exterior and an interior of the inflatable element. The inflatable element is capable of being connected to a sand screen and the inflatable element can be inflated with the gravel laden slurry during a gravel packing of the well. Watson **does not** disclose filling the inflatable element with an inflating fluid obtained by filtering the particulates from a gravel laden slurry. To the contrary, Watson **specifically** teaches that the fluid filling the inflatable element is the gravel laden slurry—that is, the **combination** of the fluid **and** the gravel. Accordingly, Watson does not cure the above-cited deficiencies of Malone as regards the pending claims, and particularly to the limitation that the inflatable element be adapted to be filled with filtered fluid. Accordingly, Malone and Watson do not, even in combination, teach or suggest each of the limitations of any of the pending claims.

The Szarka Reference:

Szarka is directed to an isolation gravel packer having a first zone isolation packer located below a first production screen, for sealing the well annulus below a first production zone.

The zone isolation packer includes elastomeric packing elements and an inflation port communicated with a lower end of a compression piston which moves axially and longitudinally compresses, thus radially expanding a sealing element. Szarka **does not** disclose expanding the sealing element using an inflating fluid obtained by filtering the particulates from a gravel laden slurry. Szarka **specifically** teaches that the zone isolation packer is expanded and sealed to the well bore **prior to** the introduction of slurry. Accordingly, Szarka does not teach inflation of an inflatable element with fluid produced by filtering of gravel-laden slurry.

The Wilson Reference:

Like Malone, Wilson teaches inflating a packer with fluids, and teaches filtering such fluids in order to remove undesirable particulate matter. Wilson does not, however, teach the use of gravel laden slurry in any respect, and specifically fails to teach the inflation of a packer with fluid produced by filtering of gravel laden slurry. Accordingly, Wilson fails to cure the above-cited deficiencies of Malone, Watson and Szarka.

Fee Statement

The total number of claims is unchanged and the number of independent claims is unchanged by way of the present Response. Accordingly, Applicant submits that no fees are due in connection

with this response. If any fees are due, please charge our Deposit Account No. 03-1130.

Conclusion

Applicant respectfully submits that none of the art cited by the Examiner either alone or in combination teaches, suggests or discloses an inflatable element adapted to be inflated by an inflating fluid obtained by filtering the particulates from a gravel laden slurry using a particulate filter. In view of the foregoing, the Examiner is respectfully requested to allow claims 1-49 and 53-55 presented for consideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 23rd day of September, 2005.

Respectfully submitted:



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Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 1 and 2.

These sheets replace the original sheets including Figures 1 and 2.

In Figure 1, element 32 has been deleted. In Figure 2, numeral 61 has been added.

Attachment: (2) Replacement sheets

(2) Annotated Sheets showing drawing changes

ANNOTATED
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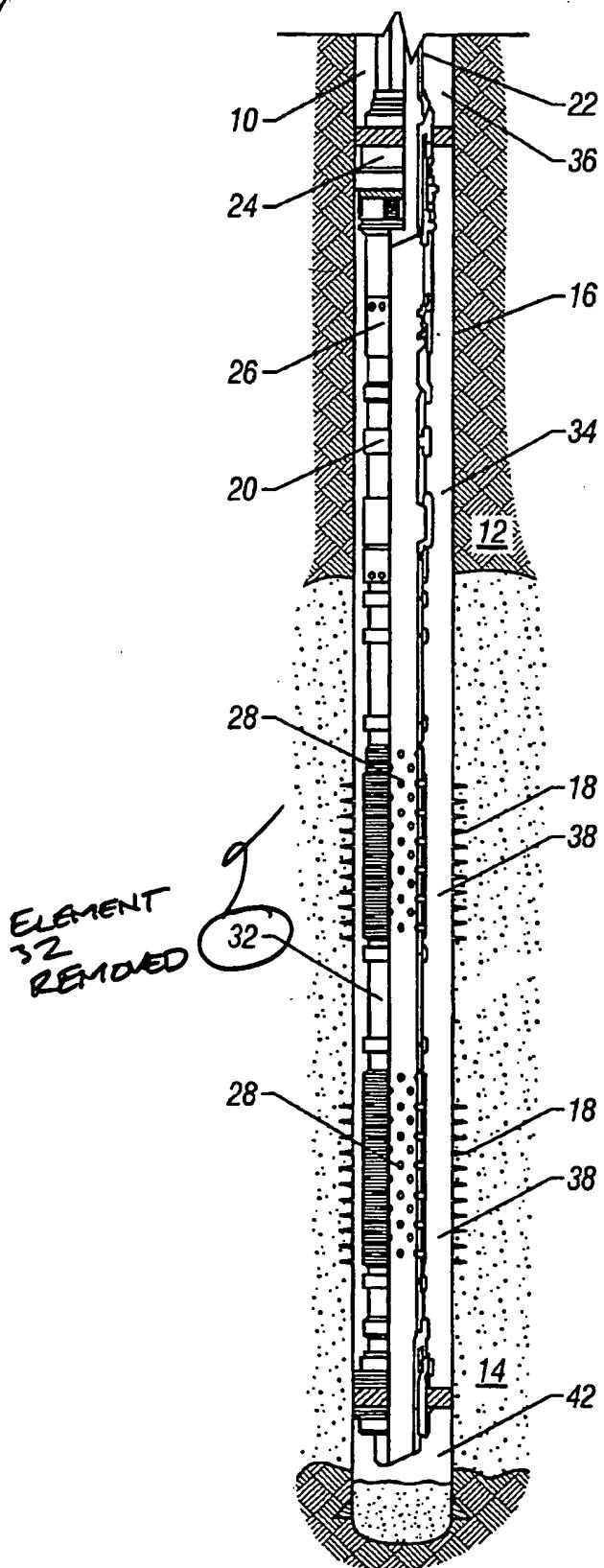


FIG. 1
(Prior Art)

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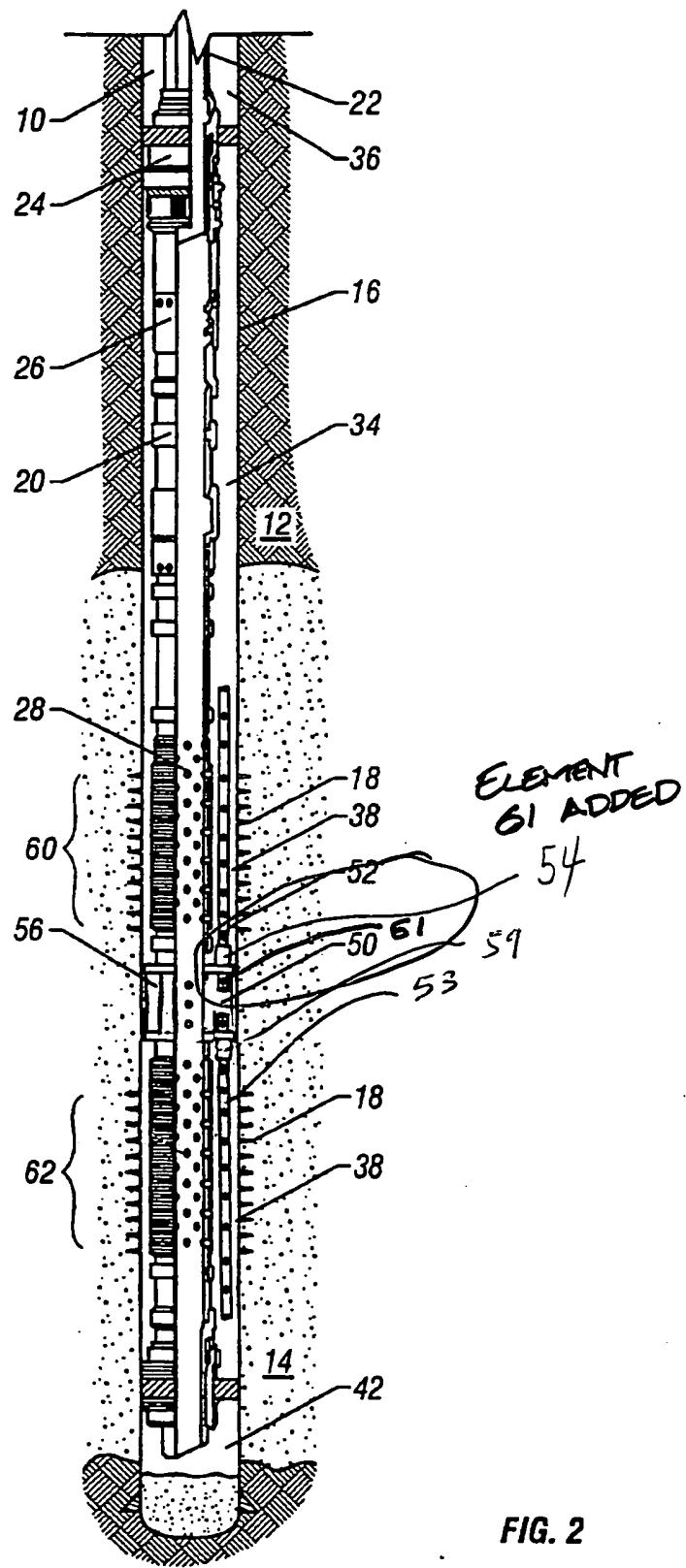


FIG. 2